

REMARKS

Upon entry of the proposed amendment, Claim 12 will be amended. Claims 1-11 have been cancelled. Independent Claim 12, with Claims 13-20 depending therefrom will remain for consideration.

In the Final Office Action the Examiner rejected Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al. (US Patent Publication 2005/0034376). Claims 13, 15, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132) for the same reasons as the rejection of Claim 13, and further in view of Etani (US 3,946,362). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. (US Patent Publication 2005/0034376) in view of Dugan (US 3,855,132) for the same reasons as the rejection of Claim 17, and further in view of Hunt (US 5,103,601).

In the Final Office Action the Examiner further rejected Claims 12, 13, 15-17, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dugan (US 3,855,132) in view of Beechert et al. (US 5,242,591). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (US 3,855,132) in view of Etani (US 3,946,362) (since Claim 14 depends from Claim 13, Applicant will assume that the Examiner has intended this combination of references to include the patent to Beechert et al. as well). Claim 18 was

rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (US 3,855,132) in view of Hunt (US 5,103,601) (since Claim 18 depends from Claim 17 Applicant will assume that the Examiner has intended this combination of references to include the patent to Beechert et al. as well).

Applicant has amended independent Claim 12 to more clearly define over the applied references, and will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Initially, Applicant respectfully traverses the rejections of the Claims based on the U.S. Patent Application Publication to Pourdeyhimi et al. In this regard, Applicant has submitted herewith a supplemental declaration under 37 C.F.R. § 1.131 by Richard C. Litman, registered patent attorney and CEO of Litman Law Offices, Ltd. The declaration by Mr. Litman includes, in Exhibit B, photographs of a model submitted to Litman Law Offices, Ltd. by Robert W. Jones, the inventor of the subject matter described and claimed in the above-identified patent application. The model was submitted to Litman Law Offices, Ltd. on or about March 19, 2003 as part of a disclosure of his invention, for the purposes of having a preliminary patentability search conducted (See: DECLARATION UNDER 37 C.F.R. § 1.131, filed September 24, 2005, and Exhibit D

attached thereto). The model shown in the photographs of Exhibit B is the same model that was demonstrated and shown to Examiner Joseph W. Drodge at the personal interview conducted June 1, 2005 and attended by Applicant's representatives Warren S. Edmonds and Robert W. Gibson. The § 1.131 supplemental declaration by Mr. Litman, when taken in conjunction with the declaration under 37 C.F.R. § 1.131 filed on September 24, 2005 by inventor Robert W. Jones, clearly establishes that the presently claimed invention was conceived and reduced to practice prior to the effective filing date of the Pourdeyhimi et al. U.S. Patent Publication Document, thereby rendering moot the application of the Pourdeyhimi et al. reference as prior art against Applicant's claimed invention. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al. Applicant further requests reconsideration and withdrawal of the rejections of Claims 13-15 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over a combination of references, Pourdeyhimi et al., Dugan, Etani and Hunt, wherein the Pourdeyhimi et al. reference is applied as the basic reference in each of the rejections.

Rejection of Claims 12, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Pourdeyhimi et al.

Pourdeyhimi et al. discloses a filler or pack material that is porous, of low density, and may be cut and molded to fit in a gutter. Pourdeyhimi et al. recites that the filler "can

easily [be] cut or molded into the right shape to pack a gutter. Fig. 1A illustrates a preferred embodiment of such a product 10, and Fig. 1B shows product 10 packed into a gutter G in accordance with the invention (Pourdeyhimi et al., paragraph [0053], lines 3-7).” And, in Claim 1, lines 9-12 Pourdeyhimi et al. recites, “said porous filler material is positioned in the roof gutter so as to substantially fill the roof gutter”. Pourdeyhimi et al. does not show: 1) a filter cross-section in the form of a truncated right triangle, 2) a planar angled side, 3) a lower side having a lower forward edge proximate to the lower edge of the rear side, and 4) the planar angled side extending between the front edge of the upper side to the lower forward edge of the lower side. A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). Thus, since each and every element of the claimed invention is not shown in the prior art reference to Pourdeyhimi et al., the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Rejection of Claims 13, 15, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. in view of Dugan.

The Pourdeyhimi et al. reference has been discussed above. The patent to Dugan discloses an open trough filler 2 made of porous polyurethane foam material, for placement in a rain gutter 1. The filler 2 extends from the front to the back of the gutter 1, and a space or open passageway 8 is left between the bottom of the filler 2 and the bottom of the gutter 5. This open passageway configuration may be achieved by the formation of a slot in the lower portion of the filler, or by providing spaced supports along the length of the gutter bottom 5 to support the filler and maintain the open passageway. Regarding the material that Dugan employs for his trough filler, he states that, "An example of a suitable porous solid is one with 95 percent void volume with an average of 10 pores per lineal inch (Dugan, col. 2, lines 36-38)." The Examiner believes that it would have been obvious to modify the Pourdeyhimi et al. filter by utilizing the filler material of Dugan, and to manufacture the filter material of Pourdeyhimi et al. in four-foot lengths as taught by Dugan as well. However, Applicant can find nothing in the patent to Dugan that would overcome or supply that which is lacking in the basic reference to Pourdeyhimi et al. noted above. In this regard, like Pourdeyhimi et al., Dugan does not show: 1) a filter cross-section in the form of a truncated right triangle, 2) a planar angled side, 3) a lower side having a lower forward edge proximate to the lower edge of the rear side, and 4) the planar angled side extending between the front edge of the upper side to the lower forward edge of the lower side. To establish a *prima facie* case of obviousness the prior art references to Pourdeyhimi et al. and Dugan must teach or suggest all of the claim limitations, and since neither Pourdeyhimi et al. nor Dugan teach or suggest the above-noted limitations found in Applicant's amended

Claim 12, the rejection of the Claims under 35 U.S.C. § 103(a) based on these references is improper and should be withdrawn.

Rejection of Claims 14 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Pourdeyhimi et al. in view of Dugan and Etani or Hunt, respectively.

The Etani patent and the Hunt patent, relied upon by the Examiner in rejecting dependent claims 14 and 18, respectively, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of Pourdeyhimi et al and Dugan noted above. Therefore, the rejections of Claims 14 and 18 under 35 U.S.C. § 103(a) based on the patents to Etani and Hunt are improper and should be withdrawn.

Rejection Claims 12, 13, 15-17, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dugan in view of Beechert et al.

The patent to Dugan has been discussed above. The patent to Beechert et al. discloses an apparatus for filtering rain gutters in the form of a seamless, elongated tube 20 made of a plurality of individual strands 22 woven together into a grid. The tube is flexible and resilient and may be placed in a rain gutter 30. The width 32 of the tube 30 is slightly wider than the gutter width 34, so that the elongated tube sides 26 gradually deform as the elongate tube is pressed into the gutter. The Examiner believes that it

would have been obvious to manufacture the filter insert of Dugan to have an angled side as taught by Beechert et al. “in order to better fit the insert into gutters having an angled outer wall (Office Action, p. 6, lines 18-19).” The Examiner further states, “Beechert et al. teach small voids of a triangular shape formed between side and bottom walls of gutter and filter insert. It would have been further obvious to one of ordinary skill to have manufactured the filter foam insert of Dugan to contain such triangular shaped void as taught by Beechert, in order to allow easier insertion and removal of the insert into the gutter walls when the gutter walls themselves have a triangular shaped side (Office Action, p. 7, lines 5-10).” Applicant does not agree with the Examiner’s conclusion. In this regard, the elongated tube 30 of Beechert et al. is formed slightly wider than the gutter into which it is being inserted so that the tube sides 26 deform as the elongated tube is pressed into the gutter. The filter sidewall of Beechert et al. is not “manufactured” with an angled sidewall so that the filter will insert easier in to a gutter. To the contrary, the Beechert et al. filter is purposely made wider than the gutter, so that it may be press fit therein. There is absolutely no teaching in Beechert et al. to “manufacture the filter insert of Dugan to have an angled side as taught by Beechert et al.”, as the Examiner urges in his rejection, “in order to better fit the insert into gutters having an angled outer wall.” Thus, there is clearly no suggestion or incentive in the applied references Dugan and Beechert et al., to modify the Dugan filter insert as urged by the Examiner, absent the teachings of Applicant’s own disclosure. Additionally, Beechert et al. fails to supply other features recited in Applicant’s amended claims, which are also lacking in the basic reference

to Dugan, noted above. Those features which are not disclosed in either Dugan or Beechert et al. being: 1) a filter cross-section in the form of a truncated right triangle, 2) a planar angled side, 3) a lower side having a lower forward edge proximate to the lower edge of the rear side, and 4) the planar angled side extending between the front edge of the upper side to the lower forward edge of the lower side. Since these features are not taught or suggested by either Dugan or Beechert et al., and as noted above the teachings of Beechert et al. simply do not suggest to one of ordinary skill in the art to manufacture the filter insert of Dugan with an angled side wall as the Examiner proposes, the rejection of claims 12, 13, 15-17, 19 and 20 under 35 U.S.C. § 103(a) based on Dugan in view of Beechert et al. is improper and should be withdrawn.

Rejection of Claims 14 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Dugan in view of Beechert et al. and Etani or Hunt, respectively.

The Etani patent and the Hunt patent, relied upon by the Examiner in rejecting dependent claims 14 and 18, respectively, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of Dugan and Beechert et al. noted above. Therefore, the rejections of Claims 14 and 18 under 35 U.S.C. § 103(a) based on the patents to Etani and Hunt are improper and should be withdrawn.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of either the gutter filler of Pourdeyhimi et al., or that of Dugan. Indeed, some of the limitations recited in Applicant's claims are not even shown in the references. It is only by impermissible hindsight and reliance on Applicant's own disclosure that the Examiner would have been led to reconstruct the gutter filler of Pourdeyhimi et al. or Dugan, so as to derive Applicant's claimed gutter and filter insert from the applied teachings. It is therefore Applicant's conclusion that the combined teachings of Pourdeyhimi et al., Dugan, Beechert et al., Etani and Hunt fail to establish a *prima facie* case of obviousness.

Applicant respectfully submits that the proposed amendments made herein properly respond to the outstanding Final Rejection and represent a *bona fide* effort to satisfactorily conclude the prosecution of this application. Care has been exercised to insure that no new matter has been introduced and that no new issues have been raised that would require further consideration or search. It is felt that no inordinate amount of

Application No.: 10/751,510
Art Unit: 1723

Attorney Docket No.14991.01
Confirmation No.3347

time will be required on the part of the Examiner to review and consider this amendment. Applicant respectfully requests entry and favorable consideration of the proposed amendment. In the event that the application is not allowed, it is requested that this amendment be entered for purposes of appeal.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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RWG/dht
Attachments: Declaration under 35 CFR § 1.131
Exhibits A & B